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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,011	06/15/2000	Tooru Kamibayashi	04329.2320	9094

22852 7590 12/31/2003

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EXAMINER
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LEE, CHI CHUNG

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/594,011

Applicant(s)

KAMIBAYASHI ET AL.

Examiner

Chi-Chung E Lee

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 4,5,11 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim 1**, the term "**controlled**" is a relative term, which renders the claim indefinite. The term "**controlled**" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Without such disclosure one of ordinary skill in the art would not be able to determine how the electronic device will react in accordance with the revocation information and renders the claim indefinite. Appropriate correction is required.

Regarding claims 2, 9, the term "**checking**" is an ambiguous term, which renders the claim indefinite. The term "**checking**" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. Without such disclosure one of ordinary skill in the art would not be able to determine the controller is determining the electronic device ID is either matching, or mismatching with what kind of information in the revocation list and renders the claim indefinite. Appropriate correction is required.

**Claims 3-7, 10-12 are rejected by virtue of their dependencies.**

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3, 6, 8-10, are rejected under 35 U.S.C. 102(e) as being anticipated by Traw et al (US 5,949,877 A).

As per claim 1, Traw discloses a storage medium (i.e. device B, see column 6 lines 60-67) comprising a specified storage on which revocation information (i.e. Certificate Revocation List, see figure 3) is registered [see column 9 lines 8-20], the revocation information designating at least one electronic device (i.e. device A, see column 7 lines 1-4] in which use of the storage medium by the designed electronic device is to be revoked [see column 7, lines 44-61].

As per claims 2, 3, Traw discloses a storage medium comprising a controller 116 [see figure 1b] for receiving the device ID information from the electronic device and

determine whether device ID is in the CRL [see figure 1b step 114]. Traw discloses if device ID (i.e. Aia) is on the list, then electronic device will be considered as a non-compliant system and a subsequent process is halt (i.e. refuses to continue, see column 7 lines 14-31 and figure 1b step 108].

As per claims 8,9,10, the claimed steps correspond to the functions of the elements of the apparatus claims 1-3, which have been rejected above, and thus rejected with the same reason applied thereto.

As per claim 6, Traw discloses the specified storage is a storage area provided on a read-only non-volatile memory [see column 10 lines 51-61].

As per claim 13, the claimed steps correspond to the functions of the elements of the apparatus claim 6, which has been rejected above, and thus rejected with the same reason applied thereto.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Traw et al (US 5,949,877 A) as applied to claim 1 above.

As per claim 7, Traw discloses the specified storage is a storage area provided on a read-only non-volatile memory [see column 10 lines 51-61]. Traw does not disclose the read-only non-volatile memory can be accessed only by a secret specific procedure.

It would have been obvious to a person of ordinary skill in the art to access the read-only non-volatile memory using a secret specific procedure since the revocation list is important it must be secret-guarded or else an intruder can change it. Thus only the entity having specific procedure can access it.

As per claim 14, the claimed steps correspond to the functions of the elements of the apparatus claim 7, which has been rejected above, and thus rejected with the same reason applied thereto.

***Allowable Subject Matter***

5. Claims 4,5,11,12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi-Chung E Lee whose telephone number is 703-306-4153.

The examiner can normally be reached on 8 am - 6 pm, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Chi-Chung Lee  
12/18/2003

  
LY V. HUA  
PRIMARY EXAMINER